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10/815,519	04/01/2004	Michael J. Ziegler	1928A1	1571
7590 PPG Industries, Inc. Law - Intellectual Property One PPG Place Pittsburgh, PA 15272			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1796	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. ZIEGLER, ROY E. DEAN,
and TRUMAN F. WILT

Appeal 2009-002461
Application 10/815,519
Technology Center 1700

Decided:¹ July 27, 2009

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 the final rejection of claims 16, 20-27, and 29-51. The subject matter of claim 28 has been indicated as

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

containing allowable subject matter. (Br. 2). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

Appellants' invention is directed to a composition that comprises an oligomer. (Spec. 1).

Claim 16 is illustrative:

16. A composition comprising an oligomer comprising:

(a) a polyol portion comprising a polyol modified with a fatty acid, wherein the polyol comprises a tetrahydric alcohol, a pentahydric alcohol, and/or a hexahydric alcohol, and

(b) a free radical curable portion,

wherein the oligomer is substantially free of any ester linkages formed from the reaction of the polyol portion with a compound having more than one functional group that introduces an ester linkage onto the oligomer; and

wherein the free radical curable portion is cured by free radical initiation.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Van Den Berg

WO 99/47617 A1

Sep. 23, 1999

Appellants appeal the following rejection:

Claims 16, 20-27, and 29-51 are rejected under 35 U.S.C. § 103(a) as unpatentable over Van Den Berg.

Appellants do not contest the Examiner's finding (Ans. 3-4) that Van Den Berg's describes a composition that comprises an oligomer that is the

same as the oligomer utilized in the claimed composition (App. Br. 3-4 generally). Appellants also do not contest the Examiner's finding (Ans. 4) that the photoinitiators of Van Den Berg's composition have free radical generating ability. Instead, Appellants argue the compositions of the claims are cured by free radical initiation and such compositions are neither disclosed nor suggested by Van Den Berg's composition that is cured by oxidative drying. (App. Br. 3-4). Appellants specifically cite page 1 of Van Den Berg, lines 22-26 and page 13, lines 14-18 in support of this argument. (App. Br. 4). However, Appellants do not respond to the Examiner's citation (Ans. 4-5) to page 13, lines 21-23 of Van Den Berg that discloses the photoinitiators generate free radicals for curing the composition.

ISSUE

Having conceded that Van Den Berg's and Appellants' compositions comprise oligomers that are the same, the sole issue on appeal is as follows: have Appellants satisfied their burden of showing that the photoinitiators of Van Den Berg's compositions do not generate free radicals for curing the composition? We decide this issue in the negative.

PRINCIPLES OF LAW

Where the claimed and prior art products are identical or substantially identical, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977). Whether the rejection is based on 'inherency' under 35 U.S.C. § 102, on 'prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the

burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. *Best*, 562 F.2d at 1255.

FACTUAL FINDINGS (FF)

We rely on the Examiner's factual findings stated in the Answer (Ans. 3-5) and Final Office Action (2-4).

ANALYSIS²

The Examiner's finding that Van Den Berg's and Appellants' compositions comprise oligomers that are the same as required by the claimed invention (Ans. 3-5; Final Office Action 2-4) properly shifted the burden of showing that the photoinitiators of Van Den Berg's compositions do not generate free radicals for curing the composition, especially since the Examiner identified that Van Den Berg discloses that the photoinitiators do generate free radicals (*see* FF). *Best*, 562 F.2d at 1254-55.

However, Appellants have not relied upon any evidence to establish that the photoinitiators of Van Den Berg's compositions do not generate free radicals for curing the composition. Consequently, Appellants have not satisfied their burden.

² Appellants do not present separate arguments for the rejected claims. (App. Br. 3-4). We select claim 16 as representative. Accordingly, we will limit our discussion to independent claim 16.

DECISION

We affirm the Examiner's § 103(a) rejection of claims 16, 20-27, and 29-51 over Van Den Berg.

ORDER

AFFIRMED

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ssl

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